

REMARKS

Introduction

In the Advisory Action dated November 9, 2010, the proposed amendments filed after the final rejection, but prior to the date of filing an Appeal Brief, were not entered. Applicant is submitting these claim amendments so that they can be entered with this Request for Continued Examination.

Amendments to the Claims

Claims 1-26 and 28, 30 and 31 are cancelled.

Claims 27 and 29 are pending in the instant application. Claims 27 and 29 are amended to state that there are four finger holes in the claimed massage device.

Claim Rejections – 35 USC § 103

Claims 27, 28 and 31 are rejected under 35 USC § 103(a) as being unpatentable over McNair (US D233,703) in view of York (US 6,241,696) and Ferrier (US 2,806,470).

Applicant respectfully disagrees that pending claim 27 is obvious based on the combination of McNair in view of York and Ferrier.

McNair, a design patent, is directed to a hand held electric massager. As such, the massage aspect of this device as an electric massager presumably would be in the vibration of it. Indeed, being a design patent, the McNair patent was granted based on the ornamental aspects of design, not functional or utilitarian aspects.

The non-functional aspects of the McNair device are clear from the figures in the patent. Both Figures 2 and 3 of McNair illustrate an orb-like arch of the tool that is particularly rounded. Due to its rounded, orb-like construction, only a small percentage of the uppermost portion of the McNair tool can be applied to the body receiving a massage at one time: either directly in a downward motion or side to side in a rocking/swinging motion. In contradiction to the claimed invention, the McNair tool is not designed for, nor can it function as, as a device for maximum contact with the body when using the device for a massage. The massaging device of the claimed

invention is designed for effleurage and petrissage movement when held by the user. In massage therapy, the effleurage movement is carried out by the by a masseur/masseuse with a flat palm(s), in a slow, sweeping movement that usually involves firm pressure. A petrissage movement is where a masseur/masseuse is kneading muscle against muscle or muscle against bone.

The McNair device cannot provide a massage that includes either effleurage or petrissage movement. The roundness on all sides of its center-point of the orb would make it difficult to grip the skin of the body receiving the massage: the center-uppermost point of the orb would be depressed onto the skin but the sides of the orb would graduate away, making the slightest movement or application of pressure of any kind to cause the user's grip on the skin to slip away.

In contrast, as claimed, the unitary arched dome member of the claimed invention is gradually arched yet sufficiently flattened so as to permit maximum contact with the body receiving a massage from the device. The gradual arch with flattened area provides the necessary surface area required for fluidity of movement and effectiveness to maintain comfort to the body receiving the massage and the user can apply all of its uppermost surface to the recipient's skin in an effective and controlled movement (i.e. no slipping or lack of traction/grip on the recipient's skin), allowing sweeping effective effleurage and more intense petrissage movements. The McNair device cannot accomplish a full range of massage movements, whereas the claimed invention overcomes these deficiencies.

To overcome the deficiencies of McNair, York is cited as having an arched dome member with a longer length than the hand grip and having a generally isosceles trapezoid shape overall. The Advisory Action also states that "York teaches a similar hand held massager that has a body similar to that claimed and taught by McNair. Motivation to combine the main body portion of York with McNair can simply be to have a more comfortable grip, a more compact design to save space, and an even larger surface area for massage. There is nothing structurally in McNair preventing a change in shape and it appears as though McNair would work equally well with such a modification. Such a modification is a mere change in shape without a change in function that does not patentably distinguish an invention over the prior art."

Applicant respectfully disagrees. First, there is no reason why one of ordinary skill in the art would modify the electrical device of McNair with features of York. York is a manual hand held massage implement with a circular, rotating balls that contact the body receiving the massage. The working premise on using the rotating balls in York is that the user can roll the balls up and down or from side to side on a given area to produce a 'massage effect.' With the York device, contact with the recipient's skin is specifically limited to the top point of each ball, i.e., the upper-most point of the orb as it rolls across the skin, which results only in a mere quasi-effleurage movement that is limited in both scope and depth. Because the York device is so widely-arched, only two balls will ever be touching the recipient's skin if applied directly (in a downward motion or a rocking movement (i.e. from side to side in a swinging motion). The York device lessens the functionality and effectiveness of the effleurage movement.

Ferrier is cited for its showing of finger holes in a massage apparatus. The Ferrier massage apparatus is designed to envelope a body part, such as a leg, with an elastic diaphragm and applying compression with both hands holding onto the apparatus. Figure 3 of Ferrier shows this massage apparatus in use over a person's leg. Ferrier's apparatus has multiple finger holes for the fingers of both hands, including the thumbs. While the Ferrier apparatus shows finger holes, there is no reason why one of ordinary skill in the art would look to the Ferrier device to modify McNair or York.

Applicant submits that there is not a motivation in McNair or York to modify the devices as noted in those patents. McNair's massage device is an electrical massager. York's massage device uses rotating balls as a massager. There is nothing in either patent to motivate a person of ordinary skill in the art to make modifications as indicated by the Examiner.

For these reasons, the Examiner is requested to withdraw this rejection.

Claims 29 and 30 are rejected under 35 USC 103(a) as being unpatentable over McNair (US D233,703) in view of York (US 6,241,696), Ferrier (US 2,806,470) and Back (US D408,543).

Applicant respectfully disagrees that pending claim 29 is obvious based on the combination of McNair in view of York, Ferrier and Back. The combination of McNair, York and Ferrier are

discussed above and are distinguishable from claim 29 for the same reasons as for claim 27. Claim 29 includes the feature that the bottom portion of the hand grip is concave. Back, a design patent, is cited by the Examiner for showing a hand-held massager with a concave hand grip. Applicant disagrees that the hand grip of Back is concave. Instead, as seen in Figure 1 of Back, the hand grip would be called a "pistol grip" with a notch that orients the hand in a vertical orientation. While there is a concave portion in the pistol grip of Back's massager, one of skill in the art would not look to Back, nor substitute its pistol grip hand grip. The McNair tool was designed solely as an electric massager, i.e., the vibrations produced by the electronic element of the tool would provide a superficial vibrational massage. The large, uppermost portion of the tool as shown in Figures 1, 2 and 3 of McNair was designed to house the electrical element. The orb-like roundness is not suitable for the main and varied movements of effleurage or petrissage in a massage as is the design, and as claimed, in the instant invention. A variation on the handgrip would not remedy the design limitation of McNair.

Conclusion

In view of the above amendments to the claims and the comments on the cited references, Applicant believes the pending application is in condition for allowance. Accordingly, Applicant respectfully requests that the Examiner issue a Notice of Allowance.

Applicant herewith submits the Request for Continued Examination fee of \$405.00.

Applicant believes no other fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 08-0219, under Order No. 2204884.00120US1 from which the undersigned is authorized to draw.

Respectfully submitted,

Dated: December 29, 2010

/Hollie L. Baker/
Hollie L. Baker
Registration No.: 31,321
Attorney for Applicant

Wilmer Cutler Pickering Hale and Dorr LLP
60 State Street
Boston, Massachusetts 02109
(617) 526-6000 (telephone)
(617) 526-5000 (facsimile)